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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,405	09/30/2003	Yasuyuki Kiuchi	116754	3755

23850 7590 08/30/2005

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

FREISTEIN, ANDREW B

ART UNIT PAPER NUMBER

1626

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,405

Applicant(s)

KIUCHI ET AL.

Examiner

Andrew B. Freistein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-73 is/are pending in the application.
- 4a) Of the above claim(s) 2,9-12,14,15,17,18,24-26,32-36,39,41 and 44-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5,16,20,22 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/23/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 2 and 4-73 are currently pending in the instant application.

Claims 1 and 3 were cancelled in a response to the restriction requirement filed on August 15, 2005.

Claims 2, 9-12, 14-15, 17-18, 24-26, 32-36, 39, 41 and 44-73 are withdrawn from further consideration by the Examiner under 37 CFR § 1.142(b) as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

Priority

This application is a Continuation of PCT/JP02/02965, filed 03/27/2002. Acknowledgement is made of Applicant's claim for foreign priority under 35 U.S.C. § 119(a)-(d), by Japanese patent applications 2001-98301 filed on 03/30/2001 and 2001-274861 filed on 09/11/2001.

Information Disclosure Statement

Applicant's information disclosure statement (IDS), filed on 02/23/2004, has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Response to Restriction

Applicant's provisional election of Group I, Claims 1, 3-8, 13, 16, 19-23, 27-31, 37, 38, 40, 42 and 43, in a response filed August 15, 2005 is acknowledged. An

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election of species was not made, and is no longer required, because Claims 1 and 3 were cancelled.

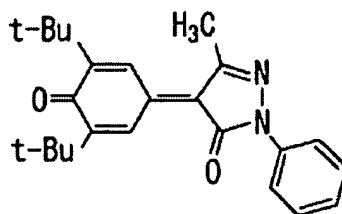
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

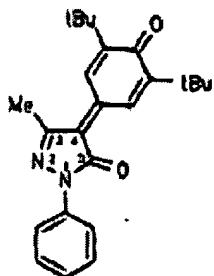
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Schulz et al.



Claim 5 claims Chemical formula (8),

Schulz et al. disclose



the compound:

(Schulz et al., "Free Radical Reactions of N-heterocyclic Compounds. XI. Reaction of 3-methylpyrazolin-5-ones with phenoxy radicals," J. fuer Praktische Chemie/Chemiker-Zeitung, Vol. 335, Issue 7, pp. 607-15 (1993). (see p. 609, col. 2)

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

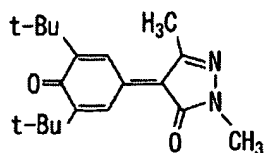
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

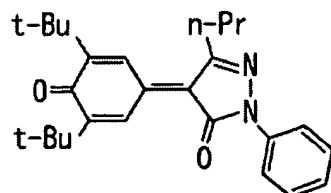
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 16, 20, 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz et al.

Claim 4 of the instant application claims a compound of Chemical formula (7):

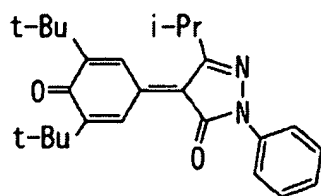


Claim 16 claims a compound of the Chemical formula (32):

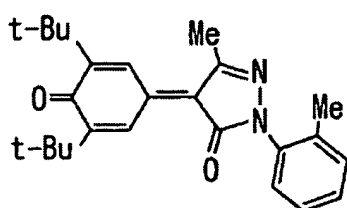


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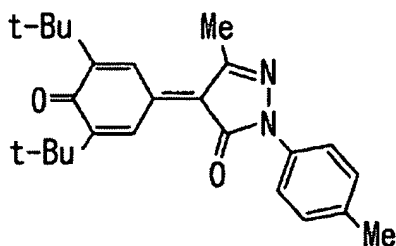
Claim 20 claims a compound of the Chemical formula (36):



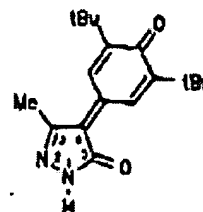
Claim 22 claims a compound of the Chemical formula (38):



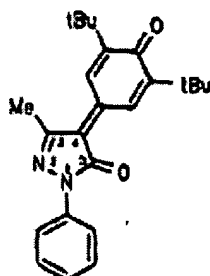
Claim 28 claims a compound of the Chemical formula (45):



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Determining the Scope and Content of the Prior Art

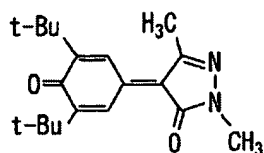
Schulz et al. disclose a compound of the formula: and a



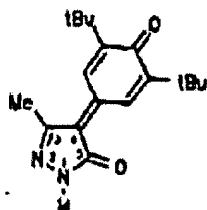
compound of the formula: (see p. 608, col. 1 and p. 609, col. 2)

Ascertaining the Differences Between the Prior Art and the Instant Application

Claim 4, Chemical formula (7), of the instant application contains a 2-pyrazole wherein a methyl group is bonded to the N atom in the 1-position of the ring,



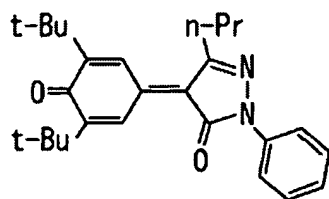
However, the first compound of the prior art discloses a 2-pyrazole ring containing a Hydrogen atom bonded to the Nitrogen atom at the 1-



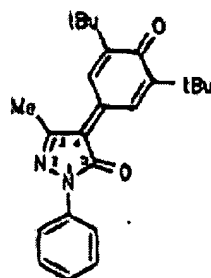
position, . As a result, the difference between the two compounds is that the instant application contains a tertiary amine in the 1-position and the prior art contains a secondary amine in the 1-position.

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Claim 16, Chemical formula (32), of the instant application claims a 2-pyrazole wherein an n-propyl group is bonded to the Carbon atom at the 3-position,



. However, the second compound of the prior art contains a

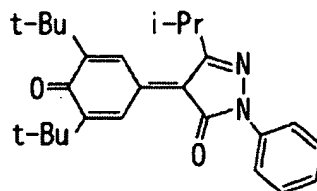


methyl group bonded to the carbon at the 3-position,

. Thus, the

difference is a methyl group versus an n-propyl group.

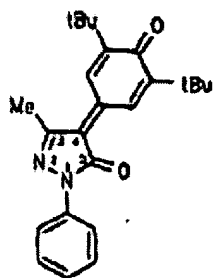
Claim 20, Chemical formula (36), claims a 2-pyrazole wherein an isopropyl group



is bonded to the Carbon atom at the 3-position

. However, the

second compound of the prior art contains a methyl group bonded to the carbon at the



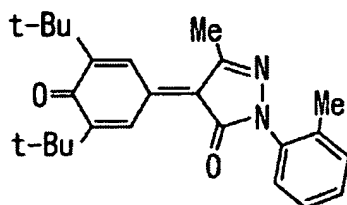
3-position,

. Thus, the difference is a methyl group versus an isopropyl

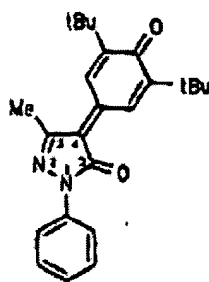
group.

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Claim 22, Chemical formula (38), claims a compound wherein the 2-pyrazole is bonded to a phenyl group at the Nitrogen 1-position. The phenyl group is substituted

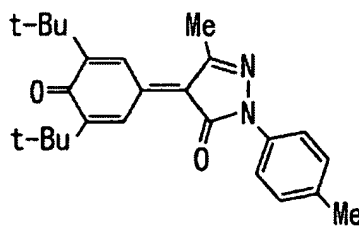


with a methyl group, . However, the prior art discloses a compound wherein the substituted phenyl group does not have any additional



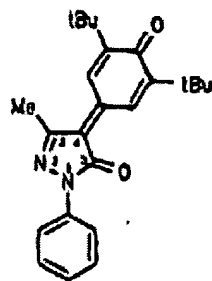
substitutions, . Thus, the difference between the two compounds is Hydrogen versus methyl on the phenyl ring.

Claim 28, Chemical formula (45), claims a compound wherein the 2-pyrazole is bonded to a phenyl group at the Nitrogen 1-position. The phenyl group is substituted



with a methyl group, . However, the prior art discloses a compound wherein the substituted phenyl group does not have any additional

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substitutions, . Thus, the difference between the two compounds is Hydrogen versus methyl on the phenyl ring.

Finding Prima Facie Obviousness

One of ordinary skill in the art would be motivated to produce a compound of **Claim 4** given the prior art reference. It is sufficient if a reference compound is so closely related to the claimed compound that a chemist would find the difference an obvious variation. Thus, claims are rejected where the difference is primarily one which exists between a secondary amine and a tertiary amine. See *Ex parte Bluestone*, 135 USPQ 199 (1961).

One of ordinary skill in the art would be motivated to produce the compounds of **Claims 16 and 20** given the prior art reference. To those skilled in the chemical art, one homologue is not such an advance over an adjacent member of a series as to make them patentably distinct inventions, because chemists that know the properties of one member of series would in general know what to expect in adjacent members. See *In re Henze*, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious, because one of ordinary skill in the art would have been motivated to prepare homologs of the compounds taught in the reference with the exception of obtaining

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compounds, which could be used in perfume compositions. Consequently, the instant claimed compounds would have been suggested to one of skill in the art.

One of ordinary skill in the art would be motivated to produce the compounds of **Claims 22 and 28** given the prior art reference. It is well established that the substitution of methyl for Hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. *In re Wood*, 199 USPQ 137 (CCPA 1978) and *In re Lohr*, 137 USPQ 548, 549 (CCPA 1963). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity. Therefore, the compounds of Claims 22 and 28 do not satisfy the statutory requirement of nonobviousness under 35 USC § 103.

Telephone Inquiry

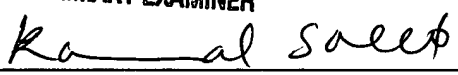
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew B. Freistein whose telephone number is (571) 272-8515. The examiner can normally be reached Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Andrew B. Freistein
Patent Examiner, AU 1626

for
KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER


Joseph K. McKane
Supervisory Patent Examiner, AU 1626
Date: August 29, 2005